

Remarks

The Applicant notes that the Information Disclosure Statement filed November 12, 2003, has never been fully considered by the Patent Office. Only one initialed page was returned with the Office Action dated June 2, 2004. The Applicant is thus enclosing a copy of the Information Disclosure Statement filed November 12, 2003, and respectfully requests the Examiner to consider the references identified therein and return an initialed copy of the 1449 forms for the Applicant's file.

The Applicant has amended the specification to correct one typographical error wherein an insulating cavity 104 had been identified as an insulating chamber. The Applicant has also amended the specification to clarify the differences between the insulating cavities defined by the internal muntin bar bodies and the insulating chamber defined by the glass panes and spacer. The internal muntin bar is disposed within the insulating chamber. The Applicant submits these amendments obviate the need to amend the claims to remove the words "insulating chamber" from the claims.

The Applicant has complied with the Examiner's suggestion to remove the "muntin bar" language from the preambles of the independent claims. The Applicant submits these amendments to do change the scope of the claims and are not related to a reason for patentability.

The current office action rejects claims 62-68, 70-76, and 78-83 as being obvious under § 103(a) in view of US Patent 5,345,743 to Baier in view of US Patent 5,732,517 to Milikovsky. The Applicant respectfully traverses the rejections. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestions or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior

art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142. The Applicant submits the third requisite criteria is not met because the combination of Baier and Milikovsky does not teach or suggest all claim limitations. The Applicant also submits the claims are patentable because the first and second criteria are not met. There is no suggestion or motivation provided in the references for making the combinations set forth in the action. There is nothing that discloses a likelihood of success. The Applicant thus submits a *prima facie* case of obviousness has not been established.

I. The current office action rejects claims 62-68, 70-76, and 78-83 as being obvious under § 103(a) in view of US Patent 5,345,743 to Baier in view of US Patent 5,732,517 to Milikovsky. The Applicant respectfully traverses the rejections.

a. Milikovsky does not disclose the elements represented in the office action

The Applicant respectfully submits the interpretation of Milikovsky set forth in the office action is not supported by any material within the four corners of the Milikovsky document. Milikovsky discloses an insulating glazing unit and a pair of spacers. Milikovsky does not, however, disclose, teach, or suggest anything about the construction of the spacer body. Despite the lack of teaching, the office action cites Milikovsky as disclosing "a plurality of insulating cavities," "the insulating cavity extending continuous in the longitudinal direction," as well as the relative spacing of the cavities and the cross sections of the cavities and the body material. The Applicant respectfully disagrees. Nothing in Milikovsky discloses or teaches the use of cavities in the body of the spacer and certainly does not disclose or teach anything about the orientation of cavities within the spacer. The office action includes a marked-up drawing that includes an

interpretation of the Milikovsky drawing Figures in order to support the rejection. The Applicant submits that such an interpretation cannot be used to properly support a rejection in this case. MPEP § 2125 provides that drawings may be used as prior art only when the picture shows all of the claimed structural features and how they are put together. The drawings must be evaluated for what the drawings reasonably disclose and suggest to one of ordinary skill in the art. Id. In this case, the office action assumes that the spacers of Milikovsky have openings, that the openings are disclosed longitudinally, and that the opens are continuous in the longitudinal direction. The action also assumes the relative dimensions of the Milikovsky spacers. The action does not, however, cite anything in the Milikovsky reference to support these conclusions. The drawings of Milikovsky reasonably disclose that the Milikovsky spacers are not intended to be a unitary material. The conclusion set forth in the office action that the spacers define openings is a conclusion drawn only with impermissible hindsight drawn from the teachings of Applicant's specification and drawings. Further, the Applicant submits the conclusion of "longitudinal and continuous" is not a reasonable interpretation of the Milikovsky teachings. The Applicant thus submits that the interpretation of the Milikovsky reference set forth in the office action does not support a *prima facie* case of obviousness and the rejections should be withdrawn.

b. No Motivation or Suggestion in the References

Element #3 of Milikovsky is a spacer as denoted at Col. 2, line 6 of Milikovsky. The window unit of Milikovsky does not have muntin bars. The Applicant submits there is no reasonable suggestion or motivation in either of the cited references to combine the elements as set forth in the office action.

Spacers and muntin bars are independent and distinct elements in the insulating glass industry. In the office action dated June 2, 2004, in this patent application, the official position of the United States Patent and Trademark Office established that the muntin bar claims of the present application are patentably

distinct from the spacer claims of the application. The office action states that “Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.” *Id.* “Distinct” inventions are patentable over each other. MPEP §802.01(II). In view of the forgoing, the Applicant submits the spacer teachings of Milikovsky cannot be properly combined with the muntin bar teachings of Baier under §103(a). Spacers and muntin bars are independent and distinct inventions serving different purposes and functions in an insulating glass unit. The Applicant thus submits there is no suggestion or motivation in the references to combine the teachings. Further, there is nothing the cited references that establishes a reasonable expectation of success. A *prima facie* case of obviousness thus cannot be established and the claims are thus patentable over the cited combination.

III. Hood Rejections of claims 69,77, and 84-93

The remaining rejections in the application are based on the combination of US 5,156,894 to Hood with the previously-applied combination of Baier and Milikovsky. The Applicants position with respect to the combination of Baier and Milikovsky is applicable to these rejections. The addition of the Hood spacer teachings does not render the claims obvious. Further, the Applicant notes that many references disclose foamed polymer muntin bars and foamed polymer spacers. For example, the Examiner first reference, Baier, discloses foamed polymer muntin bars (Col. 2, line 60). All of the claims are patentable for the recited combinations of simulated divided lite unit structures.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal Notice of Allowance for the claims.

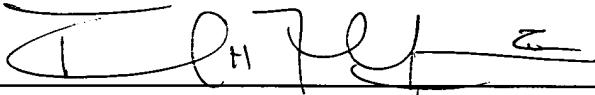
Please call the undersigned attorney if any issues remain after this amendment.



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I hereby certify that this correspondence (Amendment D in application serial no. 10/613,256 filed 07-03-2003) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 22, 2006.



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